## **REMARKS**

waveform recited in the Specification is an audio spectrograph tracing. Support for this

amended language is found in the Abstract. No new matter is being submitted.

On pages 2, 3 and 5 of the Specification have been amended to clarify the complex

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1. Amendment of Claims:

Amendment of the Specification:

The Examiner rejected Claims 1 and 2 under U.S.C. 102(b) as being anticipated by Harris (5,923,556). According to the Examiner, Harris discloses in Fig. 1A and 1B a graphic and sound coordinated novelty item as well as a method of promotion as recited in Claims 1 and 2.

In response, that Harris discloses a novelty item that include the image of the heart and an image that represents an electrocardiogram tracing. An electrocardiogram tracing does not represent the sound of heart. (See Addendum A). Therefore, the 102(b) rejection should be withdrawn.

In response to the Applicant's arguments submitted in the Amendment filed on August 22, 2003, the Examiner rejected the arguments on the grounds that the clause "produced by an audio spectrograph" does not structurally limit the claim. While the Applicant respectfully disagrees that the specific clause makes the claim a 'product by process' claim, the Applicant hereby amends Claims 1 and 2 by replacing the term "complex waveform" with "an audio spectrograph tracing" in order to overcome this rejection

The Examiner newly rejected Claim 2 under 35 U.S.C. 103(a) based on Harris in view of Applicant's own admittance. According to the Examiner, the Applicant's statement on page 2, lines 14-17 that an audio spectrograph used to produce a complex waveforms is an

admission that supports a finding of obvious. The Applicant respectfully submits that such reasoning is not sufficient to support a finding of obviousness and should be withdrawn.

The mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious unless the prior art <u>also suggests</u> the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Monteffore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

To establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specificcombination that was made by the applicant. In this instance, the Examiner has merely stated that because the Applicant admits that that all sounds can be represented by an audio spectrographic tracing, it would be obvious to replace Harris' electrocardiogram with an audio spectrographic tracing of the heart. The Applicant submits that there is no motivation, suggestion or teaching in Harris that supports the Examiner's statement.

As stated on page 2, lines 17-21, the main objective of the invention is to create a marketing tool that uses an image that depicts an object or an activity and the image of a complex waveform by an acoustic spectrograph of a sound associated with the first image. It is the Applicant's belief that most people find the presentation of a sound in a complex waveform by an acoustic spectrograph fascinating that that coupling the complex waveform with the object or activity depicted in the first image reinforces the first image in the viewer.

The Applicant submits that no prior art reference exists for a novelty or promotional

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item that uses an audio spectrograph tracing of a sound associated with an object or activity depicted or presented on the item that reinforces the object or activity with the viewer. Harris provides no motivation for replacing the electrocardiogram with an audio spectrograph tracing except for the reasons offered by the Applicant. An electrocardiogram is a graphic display or tracing showing the electrical conduction activity of the heart. An electrocardiogram does not represent the sound of the heart. In order for a viewer to understand the 'novelty' aspect of the greeting card, the viewer must only understand the specific relationship between an electrocardiogram and the heart. The viewer does not analyze the electrocardiogram to determine a sound associated with the heart.

As discussed in the previous Office Action Amendment, the images of an object or activity and an audio spectrograph tracing associated with the object or activity requires the viewer to closely review the tracing and contemplate the various sounds associated with the object or the activity. Normally, when an audio spectrographic tracing is initially seen by a viewer, the viewer tries to vocalizes a sound associated with the object or activity. The applicant submits that the viewer's contemplation and vocalization of the sound reinforces the first image, thus making the item an outstanding novelty or promotional item. Because electrocardiograms are well know and do not represent sounds, the viewer does not contemplate nor vocalize the electrocardiogram to understand the image of the heart.

In summary, "obvious to try" basis suggested by the Examiner is an improper basis for a §103 rejection when there is no suggestion in Harris to associated the image of the heart with the image depicting a sound associated with the heart.

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1	Respectfully submitted,
2	Hamble a
3	DEAN A. CRAINE, (Reg. No. 33,591)